

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

### **I. Status of the claims**

Claims 1-42 and 86-93 were pending in this application. Claims 8, and 26-30 were cancelled without prejudice or disclaimer. Claim 1 was amended to further clarify the invention. Support for claim 1 amendment can be found in cancelled claim 8. Claims 9-11, 13-15, 18, 25, 88, and 89 were amended to change the dependency from cancelled claim 8. No new matter has been introduced into the application as a result of the present amendment. Claims 1-7, 9-25, 31-42, and 86-93 are now pending in this application.

### **II. Rejection under 35 U.S.C. § 102(e) based on Mathiowitz**

The Examiner rejected claims 1, 26 (now cancelled), and 86-88 as being anticipated in view of Mathiowitz et al. U.S. Patent No. 6,143,211 ("Mathiowitz"). The Examiner alleged that the presently claimed invention is old as Mathiowitz allegedly teaches a process for preparing nanoparticles using initiator monomers. Applicants respectfully traverse this rejection.

As a general rule, for prior art to anticipate under § 102, every element of the claimed invention must be identically disclosed in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a reference is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q 193, 1098 (Fed. Cir. 1983). Applicants respectfully submit that Mathiowitz cannot be applied to support an anticipation rejection of the claims under 35 U.S.C. § 102 (e).

Mathiowitz merely relates to a polymer-based phase inversion encapsulation process for making nanoparticle and microparticle encapsulates. See Mathiowitz at Abstract and col. 4, line 13 to col. 5, line 62; and col. 5 line 66 to col.13, line 11. Example 1-4 in cols. 13-19 shows how to make the particles using polymer solutions. See col. 13, In all instances, Mathiowitz is completely silent with respect to a method for making nanoparticles having at least one polymer shell by a process of "attaching initiation monomers to the surface of the nanoparticle," contacting the nanoparticle having initiation monomers attached thereto with a transition metal ring-opening metathesis catalyst" and

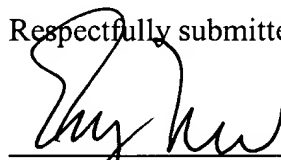
“contacting the nanoparticle with probagation monomers” as recited in claim 1. Indeed, Mathiowitz is completely silent with respect to any initiation monomers and probagation monomers. See, for instance, claims 86-88. Accordingly, Mathiowitz cannot be said to anticipate or suggest the presently claimed invention. Withdrawal of the section 102(e) rejection of claims 1 and 86-88 based on Mathiowitz is in order and is respectfully requested.

### III. Conclusion

The Applicants submit that the claims are in condition for an allowance. A Notice to this effect is respectfully requested. The Examiner is invited to contact the Applicants’ undersigned representative if the Examiner believes this would be helpful in expediting the prosecution of this application.

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Respectfully submitted,



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